

REMARKS/ARGUMENTS

Claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78 and 82-84 are currently pending in the application. Claims 20-29, 50-65 and 85-94 have been withdrawn from consideration with traverse in response to a restriction requirement. Claims 2-3, 14-16, 31-32, 44-46, 67-68 and 79-81 have been canceled without prejudice.

This amendment is being submitted with a Request for Continued Examination and a petition for a three month extension of time to extend the due date from November 18, 2010 to February 18, 2011. A credit card authorization for the required fees is being submitted herewith. The Commissioner is hereby authorized to charge any additional fees, or credit any refunds, to Chalker Flores, LLP's Deposit Account No. 50-4863.

In view of the following remarks and amendments, applicant respectfully requests a timely Notice of Allowance be issued in this case.

Request for Withdrawal of Finality of the Office Action

Applicant respectfully requests withdrawal of the finality of the Office Action because the prior "Office Action of 12/09/2009 has been issued erroneously and has been vacated." (page 2, line 3). Since the Office Action of December 9, 2010 was the first office action since the filing of the Request for Continued Examination on August 3, 2009 and that office action as been vacated, applicant respectfully submits that the Office Action of October 18, 2010 is the first office action after the Request for Continued Examination. As a result, applicant respectfully submits that the Office Action of October 18, 2010 replaces the non-final Office Action of December 9, 2009 and should, therefore, also be non-final. Accordingly, applicant respectfully requests that: (1) the finality of the Office Action of October 18, 2010 be withdrawn; (2) the Request for Continued Examination filed herewith not be entered; (3) the fee for filing the Request for Continued Examination be refunded to application; and (4) the present amendment be entered and considered on its merits.

The Office Action Addresses Old Claims

Applicant respectfully submits the Office Action addresses old claims and does not address the claim amendments made in the response filed on August 3, 2010. For example, the following excerpt from Office Action has been modified to reflect the claims as they were amended:

Claims 1, 30 and 66,

providing the shaft-driven device connected to the two or more available power sources via one or more couplings and one or more drive shafts, wherein the two or more available power sources comprise two or more mechanical sources selected from the group consisting of one or

more engines, one or more motors, one or more motor/generators and one or more turbines;

(a) analyzing market and operational data related to the two or more available power sources, and the shaft-driven device or delivery point (Fig. 1 items 35 and 36; C. 13, L. 6-11, 21,31-32; C. 17, L. 12-14); ~~wherein the two or more available power sources are connected to the device or delivery point via one or more switches or couplings;~~

(b) selecting the power source for the shaft-driven device or delivery point from the two or more available power sources based on a set of financial parameters (C. 13, L. 3740);

(c) whenever the shaft-driven device or delivery point is not already connected to the selected power source, (1) determining (i) whether it is profitable to switch the shaft-driven device or delivery point to the selected power source based on a projected potential revenue and a projected cost associated with switching to the selected power source, a time period and one or more guidelines, and (ii) whether a user has overridden switching the shaft-driven device to the selected power source (based on historical operating data, current operating data, contract data, market data and financial data), and (2) sending one or more signals to the one or more couplings to physically to switch the shaft-driven device or delivery point to the selected power source whenever it is profitable to switch the shaft-driven device to the selected power source and the user has not overridden switching the shaft-driven device to the selected power source (operating system by a computer in an automatic mode indicates "signal" feature; C. 13, L. 3744).

(page 3, lines 8-20) (amendments shown). Applicant respectfully requests that all the limitations recited in the currently pending claims be considered.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78, 80-84 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because there is allegedly insufficient antecedent basis for "sending one or more signals to the one or more switches or couplings" as recited in claim 1. Please note that the term "or couplings" was deleted in the amendment filed on August 3, 2009.

Applicant respectfully submits that claims 1, 30 and 66 have been clarified to recite that the processor sends the one or more control signals to the one or more couplings. As a result, applicant respectfully submits that claims 1, 30 and 66 are not indefinite and are, therefore, allowable under 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of the rejections are respectfully requested.

Response to Arguments

The Office Action indicated that “it would be prima face obvious to one having ordinary skill in the art at the time the invention was made to modify Mistr, Jr. to include said two or more available power sources (Fig. 1 items 35 and 36) . . . because . . . applying the known technique . . . would have yielded predictable results and resulted in an improved system.” (page 6, lines 16-22).

MPEP § 2143.D. states that to reject a claim based on applying a known technique to a known device ready for improvement to yield predictable results, the Office Action must articulate the following:

(1) a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement;”

(2) a finding that the prior art contained a known technique that is applicable to the base device (method, or product);

(3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Applicant respectfully submits that the Office Action does not articulate the required findings in such a way as to result in “an improved system” as recited in claims 1, 30 and 66 as previously presented or as currently amended.

More specifically, applicant respectfully submits that: (1) Mistr does not disclose the “base” device recited in claims 1, 30 and 66; (2) adding “a power generator/mechanical source” is not the technique being applied in claims 1, 30 and 66; and (3) adding “a power generator/mechanical source” to Mistr does not yield the “improved system” recited in claims 1, 30 and 66. Based on the claims previously presented:

(1) Mistr does not disclose the “base” device because:

- a. the identified power sources (Figure 1 items 35 (generator) and 36 (AC power source)) are electrical power sources instead of mechanical power sources,
- b. the “Load” (Figure 1) is an electrical load instead of a device connected to the mechanical sources via one or more couplings,
- c. the “Load” (Figure 1) is only connected to electrical sources (Figure 1 items 35 (generator) and 36 (AC power source)) instead of being connected to the mechanical sources via one or more couplings;

- (2) adding "a power generator/mechanical source" is not the technique being applied because operating a device connected to two or more mechanical sources via one or more couplings using the steps/criteria recited in the claims is not a known technique as of the earliest filing date of the present application and its parent applications; and
- (3) applying "a power generator/mechanical source" to Mistr does not yield the "improved system" recited in claims 1, 30 and 66 because of the deficiencies stated above in (2) and (3).

As a result, applicant respectfully submits that claims 1, 30 and 66 as previously presented are patentable over the cited references in accordance with *KSR International Co. v. Teleflex Inc.*

Claims 1, 30 and 66 have been amended to further clarify the claimed invention. Applicant respectfully submits that the foregoing distinctions also apply to claims 1, 30 and 66 as amended. As a result, applicant respectfully submits that independent claims 1, 30 and 66, as amended and dependant claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84, as amended, are patentable over the cited references in accordance with *KSR International Co. v. Teleflex Inc.*

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1, 4-13, 15-19, 30, 33-43, 45-49, 66, 69-78, 80-84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mistr, Jr. (U.S. Patent No. 6,153,943) in view of MacKay (U.S. Patent Application Publication 2005/0072164) or Clements (U.S. Patent 3,943,374), and further in view of Aasen, et al. (U.S. Patent No. 4,802,100). Applicant respectfully submits that claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78, 82-84, as amended, are patentable over the cited references for at least the reasons described below.

Claims 1, 30 and 66

Applicant respectfully submits that the cited references do not disclose, teach or suggest all of the elements recited in claims 1, 30 and 66, as amended. More specifically, applicant respectfully submits that Mistr does not disclose, teach or suggest at least the following elements recited in claims 1, 30 and 66, as amended:

- (1) a shaft-driven device connected to the two or more available power sources via one or more couplings and one or more drive shafts, wherein the two or more available power sources comprise two or more mechanical sources;
- (2) wherein the two or more mechanical sources are selected from the group consisting of one or more engines, one or more motors, one or more motor/generators and one or more turbines;

- (3) performing the claimed steps to select and switch the shaft-driven device to the selected mechanical source using the one or more couplings;
- (4) determining whether it is profitable to switch the shaft-driven device to the selected power source based on a projected potential revenue and a projected cost associated with switching to the selected power source, a time period and one or more guidelines; and
- (5) sending one or more control signals to the one or more couplings to physically switch the shaft-driven device to the selected power source.

First, applicant respectfully submits that Mistr does not disclose, teach or suggest a shaft-driven device connected to the two or more available power sources via one or more couplings and one or more drive shafts, wherein the two or more available power sources comprise two or more mechanical sources because:

- (a) the identified power sources (Figure 1 items 35 (generator) and 36 (AC power source)) in Mistr are electrical power sources instead of mechanical power sources;
- (b) the "Load" (Figure 1) in Mistr is an electrical load instead of a shaft-driven device connected to the mechanical sources via one or more couplings and one or more drive shafts; and
- (c) the "Load" (Figure 1) in Mistr is only connected to electrical sources (Figure 1 items 35 (generator) and 36 (AC power source)) instead of a shaft-driven device being connected to the mechanical sources via one or more couplings and one or more shafts.

As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

Second, applicant respectfully submits that Mistr does not disclose, teach or suggest that the two or more mechanical sources are selected from the group consisting of one or more engines, one or more motors, one or more motor/generators and one or more turbines because the selected power sources in Mistr are both electrical (Figure 1 items 35 (generator) and 36 (AC power source)). Mistr discloses a motor/generator 35, but the motor portion having a shaft is not connected to the Load. In addition, Mistr discloses turbines 17 and 23, but the shaft 10 is not connected to the Load. Mistr does not disclose engines or motors. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

Third, applicant respectfully submits that Mistr does not disclose, teach or suggest performing the claimed steps to select and switch the shaft-driven device to the selected mechanical source using the one or more couplings because there are no couplings connected to the Load and the Load is not a shaft-driven device. As a result, applicant

respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

Fourth, applicant respectfully submits that Mistr does not disclose, teach or suggest determining whether it is profitable to switch the shaft-driven device to the selected power source based on a projected potential revenue and a projected cost associated with switching to the selected power source, a time period and one or more guidelines because the portions of Mistr cited in the Office Action do not disclose a projected revenue or a projected cost associated with switching or a time period. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

Fifth, applicant respectfully submits that Mistr does not disclose, teach or suggest sending one or more control signals to the one or more couplings to physically switch the shaft-driven device to the selected power source because the signals cited in Mistr only purchase power from different electricity suppliers (col. 13, lines 37-44). Such a signal is not sent to one or more couplings to physically switch the shaft-driven device to a different mechanical source. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 1, 30 and 66, as amended.

In addition, applicant respectfully submits that modifying Mistr to correct all of the foregoing deficiencies would render Mistr “unsatisfactory for its intended purpose” (MPEP § 2143.01(V)) and “change the principle of operation” of Mistr (MPEP § 2143.01(VI)) because Mistr is designed to “generate conditioned electrical power” (Abstract, lines 4-5) and the claimed invention provides mechanical power to a shaft-driven device. As a result, “there is no suggestion or motivation to make the proposed modification” (MPEP § 2143.01(V)) and “the teachings of the references are not sufficient to render the claims *prima facie* obvious” (MPEP § 2143.01(VI)). Moreover, it would not be obvious to modify Mistr under *KSR International Co. v. Teleflex Inc.* for at least the reasons stated above in the previous section.

With respect to MacKay, applicant respectfully submits that MacKay is not a prior art reference because the earliest priority date for MacKay is August 29, 2003; whereas, the earliest priority date for the present application that discloses mechanical sources is September 6, 2001 (parent applications 09/947,719 and 09/947,728). As a result, the current claims are patentable over MacKay.

With respect to Clements, applicant respectfully submits that Clements discloses one mechanical source (gas turbine 2) driving an electrical generator (motor/generator 4) and a mechanical source (motor/generator 4) driving a shaft-driven device (compressor 7):

a unidirectional turbine, a unidirectional motor/generator and a unidirectional pump or compressor. Pumped storage plant of this type

comprises a hydraulic turbine and a pump, and the plant has two principal modes of operation, namely a generating mode during which the motor/generator acting as a generator is driven by the hydraulic turbine, the pump being inoperative; and a pumping mode during which the pump is driven by the motor/generator acting as a motor, the hydraulic turbine being inoperative.

(col. 1, lines 5-15) (emphasis added). The pump or compressor 7 is never driven by the gas turbine 2. As a result, Clements does not disclose, teach or suggest two mechanical sources that can selectively drive a shaft-driven device. Accordingly, Clements does not cure the deficiencies of Mistr.

With respect to Aasen, applicant respectfully submits that Aasen discloses a cogeneration system that generates electrical power for use in a plant or delivery to a power grid. (col. 2, lines 9-17). As a result, Aasen does not disclose, teach or suggest two mechanical sources that can selectively drive a shaft-driven device. Accordingly, Aasen does not cure the deficiencies of Mistr.

For at least the reasons stated above, applicant respectfully submits that claims 1, 30 and 66, as amended, are not obvious over Mistr and the other cited references, either alone or in combination, and are, therefore, allowable under 35 U.S.C. § 103(a). Applicant respectfully requests that the rejection of claims 1, 30 and 66 be withdrawn.

Claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84

Applicant respectfully submits that claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84, as amended, depend from claims 1, 30 and 66 which are allowable for the reasons stated above, and further distinguish over the cited references. Claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84 are, therefore, allowable under 35 U.S.C. § 103(a). Accordingly, applicant respectfully requests that any rejection of claims 4-13, 17-19, 33-43, 47-49, 69-78, 82-84 be withdrawn.

In addition and with respect to claims 17, 47 and 82, applicant respectfully submits that Mistr does not disclose, teach or suggest that the Load is selected from a group consisting of a shaft-driven compressor and a shaft-driven pump because the Load is electrically driven. As a result, applicant respectfully submits that Mistr does not disclose, teach or suggest all the elements recited in claims 17, 47 and 82, as amended. Accordingly, applicant respectfully requests that any rejection of claims 17, 47 and 82 be withdrawn.

Conclusion

For the reasons set forth above, applicant respectfully requests reconsideration by the examiner and withdrawal of the rejections. Applicant submits that claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78, 82-84 are fully patentable. Applicant respectfully

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Amdt dated Feb. 18, 2011
Reply to Office Action of Aug. 18, 2010

requests that a timely Notice of Allowance be issued in this case. If the examiner has any questions or comments, or if further clarification is required, it is requested that the examiner contact the undersigned at the telephone number listed below.

Date: February 18, 2011

Respectfully submitted,
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By 

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